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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,581	12/04/2003	Yoshiaki Oshima	1422-0613P	5076

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,581

Applicant(s)

OSHIMA ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/6/05.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's election with traverse of Group I, claims 1-12 in the reply filed on 10/6/05 is acknowledged. No reasons traversing the restriction is defined.

The requirement is still deemed proper and is therefore made FINAL.

However, applicants request rejoinder of the non elected claims. Applicants are reminded that the method of using claims (claims 13-16) can only be rejoined and the substrate claims can not (claims 17-18). In view of this, claims 17-18 should be canceled.

Although claim 14 is withdrawn, the examiner would like to comment on this claim. This claim does not properly define a process because the application step, alone, will not result in the claimed method and thus this claim should be amended to clearly define a polishing step.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima (789) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koichi et al. (175) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. (711) for the same reasons set forth in the previous office action which are incorporated herein by reference.

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Applicant's arguments filed 10/6/05 have been fully considered but they are not persuasive.

Applicants provide the statement that Oshima 789 had the same assignee at the time of the latter invention” thus it is not citable against the instant claims as of its filing date. The examiner acknowledges this statement however, said statement is **not** sufficient to overcome the rejection because it lacks the specific statement required, as defined in MPEP 706.02(1)(2) (i.e. **at the time the invention was made**). Applicants statement does not specify “at the time the invention was **made**”.

Applicants argue that Koichi et al. teaches in embodiments 1 and 2 a favorable D10 value and a favorable percentage of sizes less than 40 nm. The examiner acknowledges these teachings but these teaching are the preferred embodiments, and as is well known, a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments See *In re Van Marter*, 144 USPQ 421. Applicants also refer to the examples of the reference but a reference is not limited to only the examples. Applicants also argue that the distribution defined in the reference is on a number basis and it can not be directly compared with a distribution on a volume percent. The examiner is unclear as to this argument because the size distribution of the reference must contain a volume of sizes and burden is upon applicants to show clear evidence as to why the distribution of the reference would not constitute particles in the claimed volume relationship. It is the examiners position that from the data of the percentages for the D10 value (column 5, lines 1-5) coupled with percentages for the D50 and D90 (column 4, lines 32-41), as well as, figures 5-6, volume percents can be determined (depending on the size and density of the silica used), and this appears to encompass the claimed

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values. Applicants have not provided any clear evidence establishing that the claimed volume relationship is patentable over this reference.

Applicants argue that the distribution defined in Ota et al. is on a number basis and it can not be directly compared with a distribution on a volume percent. The examiner is unclear as to this argument because the size distribution of the reference must contain a volume of sizes and burden is upon applicants to show clear evidence as to why the distribution of the reference would not constitute particles in the claimed volume relationship. It is the examiners position that from the data of the percentages for the individual silica's, volume percents can be determined (depending on the size and density of the silica used), and this appears to encompass the claimed values. Applicants have not provided any clear evidence establishing that the claimed volume relationship is patentable over this reference. Applicants also appear to argue the examples (preferred embodiments) of this reference, but as is well known, a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments See *In re Van Marter*, 144 USPQ 421. Finally, applicants state that the instant specification (i.e. table 4) establishes unexpected results over this reference. The examiner acknowledges these results, however, any evidence provided is not commensurate in scope with the claims. The claims are much broader in scope than that defined in the tables. Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/05
MM

Michael A Marcheschi
Primary Examiner
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